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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,338	11/19/2001	Jean Sini	19111.0061	8546
23517	7590	09/29/2005	EXAMINER	
SWIDLER BERLIN LLP 3000 K STREET, NW BOX IP WASHINGTON, DC 20007			HUTTON JR, WILLIAM D	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

09/988,338

Applicant(s)

SINI ET AL.

Examiner

Doug Hutton

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11,13-19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,13-19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Applicant's Response

In Applicant's Response dated 1 September 2005, Applicant amended Claims 1, 5, 9, 13, 17 and 21, cancelled Claims 4, 12 and 20, added new Claims 25-27, and argued against all rejections previously set forth in the Office Action dated 2 May 2005.

The rejections previously set forth are withdrawn.

Claim Objections

Claims 1, 9 and 17 are objected to because of the following informalities:

- in Claim 1, the term "*application*" in Line 5 should be amended to — *application program* — because that is how the element is previously identified (see Claim 1, Line 3); Claims 9 and 17 have the same problem; and
- in Claim 1, the term "*located content*" in Line 8 should be amended to — *located translatable content* — because that is how the element is subsequently identified (see Claim 1, Line 10); Claims 9 and 17 have the same problem.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5-11, 13-19 and 21-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1, 9 and 17:

Claim 1 recites that the method for automatically translating content comprises the step of:

- *translating the located translatable content transmitted from the application program from an initial format of the content to a format supported by the mobile device **using the determined translation method** (see Lines 10-12).*

The written description of the present invention mentions nothing about "**using [a] determined translation method,**" and Applicant, in the RCE submitted 1 September 2005, provided no support for this amendment from the Specification. Accordingly, Claim 1 includes new matter that was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 9 and 17 correspond to Claim 1 and thus also include new matter, as indicated in the above discussion.

Claims 2, 3, 5-8, 9, 11, 13-17, 19 and 21-27 depend upon Claims 1, 9 and 17.

Thus, these claims also include new matter, as indicated in the above discussion.

Applicant may obviate these rejections by deleting the phrase "*using the determined translation method*" from Claims 1, 9 and 17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 9-11, 17-19 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Immonen et al., U.S. Patent Application Publication No. US 2002/0077993 A1, in view of Major et al., U.S. Patent Application Publication No. US 2004/0073626 A1.

Claim 1:

Immonen discloses *a method for automatically translating content* (see Figure 1; see Page 1, Paragraph 0005 – Immonen discloses this limitation in that the prior art includes a WAP gateway that translates web content in an HTML format into a WML format for display on a mobile device), *comprising the steps of:*

- *invoking an application program in response to an indication from a user of a mobile device to do so* (see Figures 3-5; see Page 3, Paragraph 0039 through Page 5, Paragraph 0057 – Immonen discloses this limitation in that the system for conducting wireless payments comprises a mobile user accessing e-commerce web pages);
- *scanning content generated by the application to locate translatable content* (see Figure 1; see Page 1, Paragraph 0005 – Immonen discloses this limitation in that the prior art includes a WAP gateway that translates web content in an HTML format into a WML format for display on a mobile device), *wherein the translatable content comprises at least one form that requests information from the user* (see Figures 3-5; see Page 3, Paragraph 0039 through Page 5, Paragraph 0057 – Immonen discloses this limitation in that the system for conducting wireless payments comprises a mobile user making an online purchase using a digital wallet);
- *translating the located translatable content transmitted from the application program from an initial format of the content to a format supported by the mobile device, the format supported by the mobile device being different than the initial format of the content* (see Figures 1 and 3-5; see Page 1, Paragraph 0005; see Page 3, Paragraph 0039 through Page 5, Paragraph 0057 – Immonen discloses this limitation in that: 1) the prior art includes a WAP gateway that translates web content in an HTML format into a WML format for display on a mobile device; and 2) the system for conducting wireless payments comprises a process for

converting the contents of a digital wallet into a format that is understood by the WAP gateway); and

- *transmitting the translated content to the mobile device* (see Figures 3-5; see Page 3, Paragraph 0039 through Page 5, Paragraph 0057 – Immonen discloses this limitation in that the system for conducting wireless payments comprises a process for transmitting the contents of the digital wallet to a mobile device in order to facilitate making an online purchase using a mobile device).

Immonen fails to expressly disclose:

- *analyzing the located content to determine a format supported by the mobile device; and*
- *translating the located translatable content transmitted from the application program from an initial format of the content to a format supported by the mobile device **using the determined translation method.***

Major teaches *a method for automatically translating content* (see Abstract – Major teaches this limitation, as clearly indicated in the cited text), *comprising the step of:*

- *analyzing located content to determine a format supported by a mobile device* (see Paragraphs 0075-0077 – Major teaches this limitation in that the wireless device browser system determines whether the wireless device has a suitable

converter, and, if not, converts the content to the appropriate format and transmits it to the wireless device); and

- *translating the located content from an initial format of the content to a format supported by the mobile device* (see Paragraphs 0075-0077 – Major teaches this limitation in that the wireless device browser system determines the type or format of the content, determines whether the wireless device has a suitable converter, and, if not, converts the content to an appropriate format and transmits it to the wireless device) *using a determined translation method* (see Paragraph 0050 – Major teaches this limitation in that the wireless device browser system analyzes the web page request submitted by the user to determine which converter to use when converting the content to the appropriate format), for the purpose of rendering Web content on a wireless device browser (see Paragraph 0017).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for automatically translating content, disclosed in Immonen, to include:

- *analyzing located content to determine a format supported by a mobile device;*
and
- *translating the located content from an initial format of the content to a format supported by the mobile device,*

for the purpose of rendering Web content on a wireless device browser, as taught by Major.

Claim 2:

Immonen discloses *[an] initial format of the content [that] is wireless markup language, extensible markup language, or hypertext markup language* (see Figure 1; see Page 1, Paragraph 0005 – Immonen discloses this limitation in that the prior art includes a user making a WML request to the WAP gateway by specifying a URL using the mobile device).

Claim 3:

Immonen discloses *[a] format supported by the mobile device [that] is wireless markup language, extensible markup language, or hypertext markup language* (see Figure 1; see Page 1, Paragraph 0005 – Immonen discloses this limitation in that the prior art includes a WAP gateway that translates web content in an HTML format into a WML format for display on a mobile device).

Claim 25:

Immonen discloses *[a] form [that] is filled-in with information relating to the user before being translated* (see Figures 3-5; see Page 3, Paragraph 0039 through Page 5, Paragraph 0057 – Immonen discloses this limitation in that the system for conducting

wireless payments comprises a mobile user making an online purchase using a digital wallet).

Claim 9:

Claim 9 corresponds to Claim 1 in that it recites a computer system that performs the method recited in Claim 1.

Additionally, Immonen discloses *a system for automatically translating content* (see Figure 1; see Page 1, Paragraphs 0002-0005 – Immonen discloses this limitation in that the prior art includes a computer system comprising a WAP gateway that translates web content in an HTML format into a WML format for display on a mobile device), *comprising:*

- *a processor operable to execute computer program instructions* (see Figure 1; see Page 1, Paragraphs 0002-0005 – Immonen discloses this limitation in that the prior art includes the Internet and users accessing the Internet via computers. Because Immonen discloses computers accessing the Internet, Immonen also discloses a “*processor operable to execute computer program instructions.*”); and
- *a memory operable to store computer program instructions executable by the processor* (see Figure 1; see Page 1, Paragraphs 0002-0005 – Immonen discloses this limitation in that the prior art includes the Internet and users accessing the Internet via computers. Because Immonen discloses computers accessing the Internet, Immonen also discloses a “*memory operable to store computer program instructions executable by the processor.*”).

As indicated in the above rejection for Claim 1, Immonen, in view of Major, discloses/teaches every remaining limitation in Claim 9 and provides proper motivation to combine the teachings of Major with the disclosure of Immonen.

Claims 10 and 11:

Claims 10 and 11 correspond to Claims 2 and 3, respectively. Thus, Immonen discloses the limitations expressly recited in Claims 10 and 11, as indicated in the above rejections for Claims 2 and 3.

Claim 26:

Claim 26 corresponds to Claim 25. Thus, Immonen discloses the limitation expressly recited in Claim 26, as indicated in the above rejection for Claim 25.

Claim 17:

Claim 17 corresponds to Claim 1 in that it recites computer software that performs the method recited in Claim 1.

Additionally, Immonen discloses a *computer program product for automatically translating content* (see Figure 1; see Page 1, Paragraphs 0002-0005 – Immonen discloses this limitation in that the prior art includes a computer system comprising a WAP gateway that translates web content in an HTML format into a WML format for

display on a mobile device. The functionality of the computer system is executed through a "*computer program product*."), *comprising*:

- *a computer readable medium* (as indicated in the above discussion, Immonen discloses this limitation); *and*
- *computer program instructions, recorded on the computer readable medium, executable by a processor* (as indicated in the above discussion, Immonen discloses this limitation).

As indicated in the above rejection for Claim 1, Immonen, in view of Major, discloses/teaches every remaining limitation in Claim 17 and provides proper motivation to combine the teachings of Major with the disclosure of Immonen.

Claims 18 and 19:

Claims 18 and 19 correspond to Claims 2 and 3, respectively. Thus, Immonen discloses the limitations expressly recited in these claims, as indicated in the above rejections for Claims 2 and 3.

Claim 27:

Claim 27 corresponds to Claim 25. Thus, Immonen discloses the limitation expressly recited in Claim 27, as indicated in the above rejection for Claim 25.

Claims 5-8, 13-16 and 21-24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Immonen, in view of Major, and further in view of Dutta et al., U.S. Patent No. 6,615,212.

Claim 5:

As indicated in the above rejection, Immonen, in view of Major, discloses/teaches every element of Claim 1.

Immonen, in view of Major, fails to expressly disclose/teach:

- *translating the content transmitted from the application program from the initial format of the content to an intermediate format of the content, wherein the intermediate format is different than the initial format; and*
- *translating the intermediate format of the content to the format supported by the mobile device, wherein the intermediate format is different than the format supported by the mobile device.*

Dutta teaches *a method for automatically translating content* (see Figure 4; see Column 1, Lines 9-11 – Dutta teaches this limitation, as clearly indicated in the cited figure and text), *comprising the steps of:*

- *translating the content transmitted from the application program from the initial format of the content to an intermediate format of the content, wherein the intermediate format is different than the initial format* (see Column 6, Lines 47-58; see Column 8, Lines 23-43 – Dutta teaches this limitation in that the transcoding

proxy server transcodes the content from the origin server into an intermediate format that is different from the original format of the content); and

- *translating the intermediate format of the content to the format supported by the mobile device, wherein the intermediate format is different than the format supported by the mobile device* (see Column 6, Lines 47-58; see Column 8, Lines 23-43 – Dutta teaches this limitation in that the transcoding proxy server transcodes the content in the intermediate format into a final format that is different from the intermediate format and transmits it to the wireless device), for the purpose of minimizing content transmission times (see Column 2, Lines 25-35).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for automatically translating content, disclosed in Immonen, in view of Major, to include:

- *translating the content transmitted from the application program from the initial format of the content to an intermediate format of the content, wherein the intermediate format is different than the initial format; and*
- *translating the intermediate format of the content to the format supported by the mobile device, wherein the intermediate format is different than the format supported by the mobile device,*

for the purpose of rendering Web content on a wireless device browser, as taught by Dutta.

Claims 6 and 8:

Claims 6 and 8 correspond to Claims 2 and 3, respectively. Thus, Immonen discloses the limitations expressly recited in these claims, as indicated in the above rejections for Claims 2 and 3.

Claim 7:

Immonen, in view of Major, fails to expressly disclose/teach *[an] intermediate format of the content [that] is wireless markup language, extensible markup language, or hypertext markup language.*

Dutta teaches *a method for automatically translating content, wherein the intermediate format of the content is wireless markup language, extensible markup language, or hypertext markup language* (see Column 6, Line 47 through Column 7, Line 12; see Column 7, Lines 56-62; see Column 8, Lines 23-43 – Dutta teaches this limitation in that the transcoding proxy server transcodes the content from the origin server into HTML or XML), for the purpose of minimizing content transmission times (see Column 2, Lines 25-35).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for automatically translating content, disclosed in Lee, in view of Major, to include *an intermediate format of the content that is wireless markup language, extensible markup language, or hypertext*

markup language for the purpose of rendering Web content on a wireless device browser, as taught by Dutta.

Claim 13 and 15:

Claims 13 and 15 correspond to Claims 5 and 7, respectively. Thus, Immonen, in view of Major, and further in view of Dutta, discloses/teaches the limitations of Claim 13 and 15, as indicated in the above rejections for Claims 5 and 7.

Claims 14 and 16:

Claims 14 and 16 correspond to Claims 6 and 8, respectively. Thus, Immonen discloses the limitations expressly recited in Claims 14 and 16, as indicated in the above rejections for Claims 6 and 8.

Claim 21 and 23:

Claims 21 and 23 correspond to Claims 5 and 7, respectively. Thus, Immonen, in view of Major, and further in view of Dutta, discloses/teaches the limitations of Claim 21 and 23, as indicated in the above rejections for Claims 5 and 7.

Claims 22 and 24:

Claims 22 and 24 correspond to Claims 6 and 8, respectively. Thus, Immonen discloses the limitations expressly recited in Claims 22 and 24, as indicated in the above rejections for Claims 6 and 8.

Response to Arguments

Applicant's arguments with respect to Lee (US 6,336,137), cited in rejections previously set forth, have been considered but are moot in view of the new grounds of rejection.

Applicant's arguments with respect to Major (US 2004/0073626 A1) and Dutta (US 6,615,212), filed 1 September 2005, have been fully considered but they are not persuasive.

Arguments with respect to Major and Dutta:

Applicant argues that neither Major nor Dutta discloses or suggests any sort of analysis to be performed upon the content, because both instead execute a direct, unanalyzed translation. Applicant also argues that neither Major nor Dutta discloses or suggests translating a form. See *Applicant's Response* – Page 10, second full paragraph through Page 11, first partial paragraph.

The examiner disagrees.

As clearly indicated in the above rejection for Claim 1, Major "*analyz[es] located content to determine a format supported by a mobile device*" (see Claim 1, Lines 8-9) in that the wireless device browser system determines whether the wireless device has a suitable converter, and, if not, converts the content to the appropriate format and transmits it to the wireless device. Additionally, Major teaches the wireless device browser system analyzing the web page request submitted by the user to determine

which converter to use when converting the content to the appropriate format (see Paragraph 0050).

Accordingly, Major teaches an analysis that is performed upon the content.

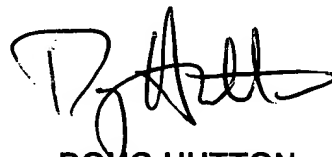
In regard to Applicant's argument that neither Major nor Dutta discloses or suggests translating a form, Immonen (US 2002/0077993 A1) discloses this limitation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
September 23, 2005

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish at the end.

**DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100**